REMARKS

Claims 1 and 3-26, 28-40 and 43-50 are pending in the present application, of which claims 1, 16 and 28 are independent.

Objection

Claim 16 is amended to overcome the objection.

35 USC § 102 Rejections

Independent claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al. (USPN 5,537,474), hereafter referred to as Brown. Independent claims 16 and 28 were rejected under 35 U.S.C. 102(e) as being anticipated by Ahn et el. (Publication number 2002/0061745), hereafter referred to as Ahn.

Neither Brown, nor Ahn discloses executing commands *in the SIM*, the commands being "related to a card holder verification (CHV) feature including enabling and disabling the CHV feature," as required by amended independent claims 1, 16, and 28. The Examiner respectfully disagrees.

Brown reference

In the Remarks section of the Office Action dated May 4, 2004, the Examiner cites Brown at column 4, lines 51-57 for the assertion "that the authentication *may* (emphasis added) take place upon invoking special services or upon the occurrence of predetermined traffic or upon events such as a request for a call." Thus, the Examiner infers "the processor must be executing commands in order to determine if the authentication algorithm is to be performed (i.e. enabled) and inherently at some point the processor will complete the authentication process and will cease to perform authentication (i.e. disable the feature)."

The cited Brown text does *not* meet the language of the independent claims. The independent claims require that the commands be executed *in the SIM*.

The cited text is within the context of USDC phones. The authentication procedure for USDC phones is explained from col 4, line 14 to col 4, line 60, which includes the cited text at column 4, lines 51-57. USDC phones do not make "provision for a smart card/SIU." Col. 4, lines 14-15. Thus, the cited text does not disclose nor infer executing commands *in the SIM* "related to a card holder verification (CHV) feature including enabling and disabling the CHV feature," as required by the independent claims.

Brown does not describe his invention until col. 5 line 18, wherein Brown states, "Turning now to FIGS. 2 and 3, a solution to this problem is illustrated in a first embodiment of the invention."

Thus, the 102(b) rejection based on Brown is overcome.

Ahn reference

In the Remarks section of the Office Action dated **May 4, 2004**, the Examiner states:

> Ahn discloses receiving a request to perform the authentication thus its processor must process this request and therefore commands are executed (see page 3 paragraphs 0045-0051). Similar to Brown the authentication must at some point complete and then it will be disabled since it is not required anymore.

While it is true that Ahn executes an authentication algorithm (page 3 par 49), that does not necessarily imply that the SIM executes "commands related to a card holder verification (CHV) feature including enabling and disabling the CHV feature," as required by the independent claims. The Examiner states that authentication "will be disabled since it is not required anymore." That statement is not necessarily true. The terminal can roam in and out of networks. When a terminal roams from one type of network to another type of network, it necessitates authentication. Thus, authentication is required again, and the SIM needs to be enabled to authenticate the terminal to operate within the new network.

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Being able to execute commands related to a CHV feature including enabling and disabling the CHV feature is an important feature of the SIM. Ahn does not disclose a SIM "enabling and disabling a CHV feature," therefore the 102 rejection based on Ahn is overcome.

Conclusion

None of the references disclose executing commands in the SIM, the commands being "related to a card holder verification (CHV) feature including enabling and disabling the CHV feature," as required by amended independent claims 1, 16, and 28. Thus, independent claims 1, 16, and 28 are patentable. Claims 3-15 and 43-50 depend on patentable independent claim 1 and are therefore patentable. Claims 17-26 depend on patentable independent claim 16 and are therefore patentable. Claims 29-41 depend on patentable independent claim 28 are therefore patentable.
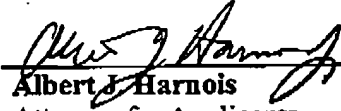
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CONCLUSION

In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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